

R E M A R K S

In accordance with the foregoing, claims 6-9, 15-17, 22-23, and 25 have been amended. No new matter is being presented and approval and entry of the amendments are respectfully requested.

Claims 6-25 are pending in the application.

EXAMINER INTERVIEW:

This Amendment is submitted in response to the interview with Examiner Kimberly Smith and her supervisor, Examiner Peter Poon, taken Tuesday, December 9, 2003 at approximately 2:00 pm.

The undersigned wishes to thank Examiner Smith and Examiner Poon for their time and courtesy extended during the interview. Both examiners helped to clarify their positions and graciously allowed the undersigned to clarify the Applicant's position with regard to patentability.

During the interview, the cited references, physical samples of Applicant's invention and the Borchelt product (sold under the name SNOOT LOOP (R)) were reviewed.

Use of the term "lofted" was discussed. Examiner Poon consulted his desktop dictionary and confirmed that Applicant's use of the term "lofted" did not contradict the dictionary meaning. The undersigned emphasized the need for Applicant to define her own descriptive term because the art itself fails to provide a singular term to generically define the class of non-flat cord.

The original specification at page 3, ln. 23-24 uses the adjective "lofted" in combination with other adjectives, such as "nylon, draw cord (soft cotton nylon braid)" to describe the

"nose piece." On the other hand, the original specification at page 3, ln. 24-25 uses the adjective "flat" to describe a "nylon strap for the collar." Applicant has consistently used the term "flat" to describe the side pieces. Applicant maintained that the term "lofted" is close to but not synonymous with non-flat. The term "lofted" also implies an airy quality of softness that is more comfortable to the touch.

Use of a filament within upper nose member 20 was discussed. A physical embodiment of the present invention, of many possible embodiments, was physically present at the interview. This physical embodiment did not have a filament within upper nose member 20. The undersigned conveyed that the claimed embodiments, absent any specific limitations, cover embodiments that do and do not contain a filament within upper nose member 20.

Applicant can be her own lexicographer. The undersigned presented evidence of the Thomas Register, the Oxford English Dictionary, and a commercial website showing use of term "flat" to describe a *type of cord* to one of ordinary skill. It was agreed that the undersigned would submit an Information Disclosure Statement so that these references would appear on the front the issued patent.

The term "connected" was discussed. Examiner Poon offered that if two people touch the table, that both are "connected" but not "directly connected." On the other hand (no pun intended), if two people were to hold hands, they would be "directly connected." In a spirit of cooperation, the

undersigned agreed that this distinction should be incorporated into the claims.

The combination of **Borchelt I** and **Borchelt II** (see below explanation) provide a tube to surround the nose strap 50 (see FIG. 1 of 5,992,352, **Borchelt I**) but that tube has open ends that are not permanently affixed to any other piece. While this tube "connects" to the other pieces through physical contact with the **Borchelt I** nose strap 50, this tube does not "directly connect" to the other pieces.

Examiner Poon and the undersigned then agreed that the claims could be modified while using the terms "connect" and "directly connect" as set forth above, to clarify how Applicant's invention distinguishes over the prior art. Following this reasoning, the term "directly contact" is also interpreted to mean contact without any intervening piece or member.

The examiners then suggested that Applicant file an Amendment After Final for consideration.

STATEMENT REGARDING REFERENCES OF RECORD:

The Office Action dated November 20, 2003 (Paper No. 24) and the Examiner interview of December 9, 2003 indicate that there has been some mutual confusion with regard to the references.

As particularly emphasized below, there are a total of four ("4") Borchelt references in this application. These four references are as follows:

1. Borchelt, U.S. Patent No. 5,992,352 ("Borchelt I") from Paper 4.
2. Snoot Loop Halter for Dogs ("Borchelt II") from IDS of 05/22/2001 (listed in IDS as "Peter L. Borchelt, Ph.D., Animal Behavior Consultants, www.animalbehavior.com.").
3. Snoot Loop order form ("Borchelt III") from IDS of 05/22/2001 (listed in IDS as "Peter L. Borchelt, Ph.D., Animal Behavior Consultants, "Snoot Loop Halter for Dogs" order form").
4. Snoot Loop Halter for Dogs ("Borchelt IV") from IDS of 08/26/2002 (listed in IDS as "Borchelt, Peter L., PhD, SNOOT LOOP HALTER FOR DOGS, August 2001, pp. 1-6.").

The undersigned attorney wishes to apologize for any confusion with regard to the references.

USE OF TERMS "FLAT," "NON-FLAT" AND "LOFTED" IN THE CLAIMS:

This invention relates to a canine head halter that has two different types of cord, one type for "upper nose member 12" and another for the remaining pieces, such as "collar member 30" and "under nose member 20." The purpose is to not irritate "the skin or fur of the dog." See specification as filed at pg. 2, line 8.

Applicant has consistently used the term "flat," which is known to those skilled in the art and supported by evidence of record, to describe members except for the upper nose member. The specification, pg. 3, ln. 22-26 is illustrative, but not exhaustive:

This dog training device is comprised of **flat**, hollow braided nylon for the side pieces, head piece and under jaw/under chin pieces; **lofted**, nylon draw cord (soft cotton nylon braid) for the nose piece; and a

flat nylon strap for the collar (behind the ear strap). All the parts are **flat** with rounded edges, except the nose piece which is round.

The term "flat" does not mean "flat like a piece of paper" but rather is a term well known to those skilled in the art to describe a **type of** cord, or tape, or rope, to wit:

THE THOMAS REGISTER: pg. COR/10976 sets forth on the top thereof an advertisement for "flat braids" to describe a style of cord.

THE THOMAS REGISTER: pg. COR/10930 sets forth an advertisement by Atkins & Pearce for "Flat Braids"; and an advertisement by Ross Mathews Mills, Inc. for "Flat Elastic, Elastic & Decorative Cord & Braid."

WESTERN FILAMENT, INC: internet product catalog for "Flat Braided Tapes".

THE OXFORD ENGLISH DICTIONARY: definition #15, special combination (pg. 18) "Some flat ropes, for mining-shafts, are made by sewing together a number of ropes, making a wide, flat band."

Therefore, the term "flat" means those type of members known to those skilled in the art to be of the flat type. Likewise, the term "non-flat" means all members to the exclusion of those that are "flat." It is understood that while the specification may disclose embodiments of flat members, such as "flat, hollow braided nylon," the term "flat" by itself is given the definition known to those of ordinary skill.

It is undisputed that the inventor may act as her own lexicographer and use the specification to supply new meanings

for terms either explicitly or by implication. As the case law cited by the Examiner in the Office Action dated March 26, 2002 states, "Applicants have the long recognized right to describe their structures in such language as they choose so long as ordinary meanings are not distorted and if they make themselves clear. *In re Leshin*, 277 F.2d 197, 200 (C.C.P.A. 1960) (Rich, J.). See also *Moba, B.V. v. Diamond Automation, Inc.*, 2003 U.S. App. LEXIS 6285, 9 (Fed. Cir. April 1, 2003) quoting *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979, (Fed. Cir. 1995) (en banc), *aff'd*, 517 U.S. 370 (1996). The term "lofted," as used in the specification, denotes a non-flat type of cord that has an airy feel. This is similar, and not inconsistent with the OXFORD ENGLISH DICTIONARY, denoting something that is hit or suspended in air.

REJECTIONS UNDER 35 U.S.C. §103

The claims generally stand rejected as obvious over **Borchelt I** in view of **Borchelt II**, DeGroot, U.S. Patent No. 4,483,275, or Tachi et al., U.S. Patent No. 4,798,174. The nose strap 50 of **Borchelt I** is combined with the "felt or flannel close fitting tube" of **Borchelt II** (see pg. 3, in ¶ labeled CAUTION) to obviate the claimed snout loop (11) and upper nose member (12). The claims define over the references as follows:

Claim 6 sets forth a single lofted upper nose member directly connected with closed first and second ends to first and second metal snout loop rings.

Claim 7 sets forth a snout loop having a non-flat portion with closed ends to directly contact the upper canine snout when worn.

Claim 17 sets forth an upper nose member directly connected by closed ends thereof to third and fourth metal rings.

Claim 22 sets forth a snout loop configured and arranged to directly contact the canine snout including a lofted upper nose member with closed ends connected to an under chin member.

A. COMBINATION OF REFERENCES NOT ALLOWED BY M.P.E.P.

It is respectfully submitted that the combined references of **Borchelt I** and **Borchelt II** actually "teach away" from combination. Because these references are from the same inventor, it is respectfully submitted that if Borchelt had intended to combine his own references, he would have.

Furthermore, M.P.E.P. § 2144.04 II, B. states:

Note that the omission of an element and retention of its function is an indicia of unobviousness. *In re Edge*, 359 F.2d 896, 149 U.S.P.Q. 556 (C.C.P.A. 1966).

The function of the omitted felt from **Borchelt II** is:

"The nose loop will slide within this soft cushioned tube, protecting the skin while you retain control of the dog." · **Borchelt II** (see pg. 3, in ¶ labeled CAUTION).

On the other hand, one function of the present invention is that it "does not irritate the dog's fur or skin." See specification at pg. 2, ln. 6.

Thus, because the element of felt is omitted and its function retained, M.P.E.P. § 2144.04 II, B. applies. Reconsideration and withdrawal of the obviousness rejections are respectfully requested.

B. NEVERTHELESS, THE CLAIMS DEFINE OVER THE COMBINATION

The tube of **Borchelt II** does not have closed ends and these ends do not directly contact pieces other than the Borchelt nose loop 50. All independent claims define over this combination as follows:

Claim 6 sets forth a single lofted upper nose member directly connected with **closed first and second ends** to first and second metal snout loop rings.

Claim 7 sets forth a snout loop having a non-flat portion with **closed ends** to directly contact the upper canine snout when worn.

Claim 17 sets forth an upper nose member directly connected by **closed ends** thereof to third and fourth metal rings.

Claim 22 sets forth a snout loop configured and arranged to directly contact the canine snout including a lofted upper nose member with **closed ends** connected to an under chin member.

C. CLAIMED METAL RINGS TO BE GIVEN PATENTABLE WEIGHT

Some claims set forth metal rings. Page 5 of the Office Action dated November 20, 2003 (Paper No. 24) sets forth:

"... it has been held to be within the general skill of a worker in the art to select a known material on

the basis of its suitability for the intended use as a matter of obvious design choice."

The Office Action does not offer citation. Presumably, the Office Action relies upon M.P.E.P. § 2144.07 to wit:

"The selection of a known material based on its suitability for its intended use supported a *prima facie* obviousness determination in *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 U.S.P.Q. 297 (1945) (claims to a printing ink ... held invalid over a reference teaching a printing ink made with a different solvent)."

However, to place this quotation in context, the title of M.P.E.P. § 2144.07 is instructive -- "Art Recognized Suitability for an Intended Purpose." In this case, the art of canine head halters fails to teach the use of metal rings as joints for side strap components. Metal rings are not and were not "known" in the canine head halter art. Moreover, the art actually teaches away from metal rings through actual use of rubber rings (K-9 KUMALONG), cord slip rings (K-9 KUMALONG), and sewn joints (SNOOT LOOP). It is therefore respectfully submitted that a *prima facie* case of obvious has not been met because the art of canine head halters does not recognize the use of metal rings.

The Applicant respectfully offers the enclosed Declaration under 37 C.F.R. § 1.132 from Ms. Alice De Groot, the inventor of the very reference relied upon by the Examiner. In short, according to Ms. Alice De Groot, not only are metallic rings "unsuitable," they were specifically rejected and suspected of causing nerve damage. According to the uncontroverted

Declaration, the substitution of metal for "DOWNHOLE" rubber in the art of canine head halters is not obvious to one of ordinary skill in the art. Accordingly, the enclosed Declaration from the inventor of the very reference relied upon by the Examiner overcomes any ***prima facie*** case of obviousness.

It is respectfully submitted that in this case, the proper rule for substitution of elements by an Examiner is given by the immediately preceding section to § 2144.07, namely M.P.E.P. § 2144.06, ¶ 2, to wit:

"...components which are functionally or mechanically equivalent are not necessarily obvious in view of the one another." M.P.E.P. § 2144.06, ¶ 2, citing *In re Scott*, 323 F.2d 1016, 1019 (C.C.P.A. 1963) (Rich, J. authoring for a ***unanimous*** five judge panel).

"The fact that the invention seems simple after it is made is not determinative of the question of obviousness. If this were the rule, many of the most beneficial patents would be stricken down." *Id.* at 1020.

Accordingly, it is respectfully submitted that use of metal rings (which are not shown by any canine head halter art what-so-ever) are not merely an equivalent substitution, but rather represent a significant departure in the art. Clearly the skepticism of an expert in the field provides compelling indicia of non-obviousness. The use of metal rings, according to the inventor provide a beneficial result in that, unlike rubber, they do not deteriorate from canine saliva. Further, metal rings provide a beneficial result in that the affixed cord may more easily rotate about the metal surface and conform to the

canine head. Moreover, metal rings provide a reduced friction surface with respect to the canine fur such that the canine fur will not be rubbed away during use.

Accordingly, it is respectfully submitted that the use of metal rings is significant and should be entitled to patentable weight.

REQUEST TO WITHDRAW FINALITY OF REJECTION:

M.P.E.P. § 706.07(a) sets forth:

Furthermore, a second or any subsequent action on the merits ... will not be made final if it includes a rejection, on newly cited art, other than information submitted in an information disclosure statement filed under 37 C.F.R. § 1.97(c) with the fee set forth in 37 C.F.R. § 1.17 (p), *of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art.*

Independent claim 7 was not Amended.

Independent claim 7 was rejected under § 102(b) in the Office Action of October 9, 2002. Independent claim 7 was not amended in the Amendment After Final dated March 17, 2003.

Independent claim 7 was rejected under 35 U.S.C. § 103(a) by way of the final Office Action dated November 20, 2003 in view of the newly cited art to **Borchelt II**.

Because independent claim 7 was not amended, and because the Examiner changed the rejection, the rejection may not be final, *in spite of the fact that other claims may have been amended to require newly cited art.*

CONCLUSION

All rejections of the Examiner have been complied with, properly traversed, or rendered moot. Thus, it now appears that the application is in condition for allowance. Should the Examiner have any questions after reviewing this Amendment, he is cordially invited to call the undersigned attorney so that this case may receive an early Notice of Allowance.

Favorable consideration and allowance are earnestly solicited.

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Respectfully submitted,



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